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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,979	05/08/2001	Michael Tolson	507-000210US	4938
20995	7590	05/13/2005	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			BATES, KEVIN T	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2155	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,979

Applicant(s)

TOLSON, MICHAEL

Examiner

Kevin Bates

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

This Office Action is in response to a communication made on November 27, 2004.

Claims 2-5 and 7-11 are pending in this application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10, 2-5, drawn to sending targeted advertisements in the form of interactive graphic objects, classified in class 709, subclass 203.
- II. Claims 11, 7-9, drawn to creating bidirectional communication links between a client and a business contact, classified in class 709, subclass 217.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as an interactive game that receives and sends score information to the business contact.

See MPEP § 806.05(d).

During a telephone conversation with Ted Cannon on May 4, 2005 a provisional election was made with traverse to prosecute the invention of II, claims 11, 7, 8, and 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10, 2, 3, 4, and 5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoyle (6141010).

Regarding claim 11, Hoyle discloses a method of providing interactive bi-directional connections between a business contact and a client (Column 7, lines 33 – 44) comprising: providing a persistent interactive graphic object configured to establish an interactive, bi-directional connection between said client and a business contact (Column 5, lines 46 – 50); providing, as part of said graphic object, at least one function that can be performed by said client (Column 5, lines 55 – 60); and transmitting information from said business contact to said persistent interactive graphic object (Column 7, lines 41 – 44).

Regarding claim 7, Hoyle discloses that said functions associated with said object include electronic messaging with said business contact (Column 8, lines 10 – 12).

Regarding claim 8, Hoyle discloses that said object can be relocated to a desktop (Column 11, lines 9 – 16).

Regarding claim 9, Hoyle discloses that said object on a desktop remains in communication with a server and may receive data from said server for updating messages, services, or links associated with said object (Column 11, lines 63 – 67).

Response to Arguments

Applicant's arguments filed November 17, 2004 have been fully considered but they are not persuasive.

The Applicant argues that the reference Hoyle does not disclose an interactive graphic object and does not disclose that the object is configured to establish an interactive bi-directional connection between said client and a business contact. The examiner disagrees, the reference, Hoyle discloses a module or object (Column 7, lines 9 – 13) that has bi-directional communication with a business contact, but sending computer usage information and acquiring advertisement information. That object also provides the user with graphical objects that the user use at least one function with which includes linking the user to a website that is related to the picture or description on the ad.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 5933811 issued to Angles, because it discloses a system which has an interactive bi-directional communication with a business contact and delivers advertisements.

U. S. Patent No. 5794210 issued to Goldhaber, because it discloses an object that tracks user interest in ads and sends it to a remote location.

U. S. Patent No. 5347632 issued to Filepp, because it discloses sending objects in the form of advertisements that include application logic.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 8 am - 4:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB

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May 6, 2005


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